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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,347	06/23/2003	Samuel D. Conzone	SGW-155	7211

23599 7590 10/25/2004

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT PAPER NUMBER

1712

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/600,347

Applicant(s)

CONZONE ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9/7/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 35-59, 61 and 79-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-7, 19-22, 24, 33, 63, 64, 67-69 and 73 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 8-18, 23, 25-32, 34, 62, 65, 66, 70-72 and 74-78 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-34, 60, and 62-78 in the reply filed on 9/7/04 is acknowledged. The traversal is on the ground(s) that a search of all the claims would not be undue burden on the examiner since the searches of both groups would comprise extensive overlapping subject matter. This is not found persuasive because, while Group I is drawn to an article, Group II is drawn to a method of using the article. There can be many ways to use the article, and the different ways to use the article would require additional searching not required by Group I.

Claims 35-59, 61, and 79-88 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Examiner's Comments***

In claim 14, the second compound in line 3 of the claim is missing a letter. Also, in claim 20, "then" should be spelled --than--. Further, regarding independent claims 1, 60 and 63, and the claim language "other molecules being chemically bondable to said functional compound when in said coating", it is the examiner's position that this is an intended use of the composition, and it is not clear how the intended use of the composition materially affects the overall claimed composition.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24 and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24 and 63 recite the limitation "the biofunctional properties" in claim 1 and 63, respectively. There is insufficient antecedent basis for this limitation in these claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7, 10, 19-21, 24, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Oviatt, Jr. et al. (hereinafter Oviatt et al.) (4,746,751). Regarding claims 1, 2, 24, and 60, Oviatt et al. disclose a surface comprising a substrate and a coating thereon of a homogeneous mixture of a fluorescently labeled and a first chemical functional compound (Abstract and col.6, lines 51-61).

Regarding claims 5-7, 10, Oviatt et al. disclose a fluorescent labeled compound as claimed (col.2, line 67-col.6, line 32).

Regarding claims 19-21, Oviatt et al. disclose amounts included in the ranges as instantly claimed (col.8, Example IV).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 22, 63, 68, and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Atwater et al. (5,280,548). Atwater et al. disclose a surface comprising a substrate and a coating thereon of a homogeneous mixture of a fluorescently labeled compound and a first chemical functional compound or hydrogel polymer (Abstract).

Claims 1, 2, 22, 63, and 67-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Leiner et al. (5,114,676). Leiner et al. disclose a surface comprising a substrate and a coating thereon of a homogeneous mixture of a fluorescently labeled compound and a first chemical functional compound or hydrogel polymer (col.3, lines 59-64 and col.4, lines 40-58).

Claims 1, 2, 22, 63, 64, 68, and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomisaka et al. (5,056,520). Tomisaka et al. disclose a surface comprising a substrate and a coating thereon of a homogeneous mixture of a fluorescently labeled compound and a first chemical functional compound or hydrogel polymer (Abstract), more specifically a hydrogel comprising amine groups (col.1, line 61-col.2, line 20).

Claims 1, 2, 22, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Haruvy et al. (5,357,015). Haruvy et al. disclose a surface comprising a substrate (col.7, lines 33-48) and a coating thereon of a homogeneous mixture of a fluorescently labeled and a first chemical functional compound (col.4, lines 3-34).

***Allowable Subject Matter***

Claims 3, 4, 8-18, 23, 25-32, 34, 62, 65, 66, and 70-72, and 74-78 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening

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claims. Regarding claims 3, 4, 8-18, 23, 25-32, and 34, the prior art of record does not appear to teach or disclose this substrate as claimed. Regarding claims 62, 65, 66, 70-72, and 74-78, the prior art of record does not appear to teach or disclose the instantly claimed hydrogel in combination with the claimed limitations.

Claim 73 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art of record does not appear to teach or disclose the instantly claimed limitation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan

October 21, 2004

*Christopher Keehan*  
*Art Unit 1712*  
*clerk*